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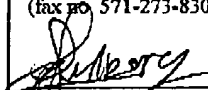
JAN 11 2007

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Keith Herszberg

Regarding the following Application:

Applicant(s): CARTER-SMITH,  
Michael et al.

Examiner: MENDOZA, Michael G.

Serial No.: 10/730,250

Group Art Unit: 3734

Filed: December 9, 2003

Docket No.: P-6406-US

Title: ACUPRESSURE DEVICE

## Attached please find:

- |                                                                                   |                                                                                              |
|-----------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> RCE Transmittal Sheet                                 | 10. <input checked="" type="checkbox"/> Petition for Three Month Extension of Time           |
| 2. <input type="checkbox"/> Signed Declaration & Power of Attorney                | 11. <input type="checkbox"/> Issue Fee Transmittal <input type="checkbox"/> Publication Fee  |
| 3. <input type="checkbox"/> Request for Correction of Recordation of Assign. and: | 12. <input type="checkbox"/> Submission of Formal Drawings: Two sets of                      |
| - Recordation Cover Sheet                                                         | ____ Sheets containing Figs. ____                                                            |
| - Copy of Notice of Recordation of Assign.                                        |                                                                                              |
| 4. <input type="checkbox"/> Recordation of Assign. Cover Sheet & Signed Assign.   | 13. <input checked="" type="checkbox"/> Response to Office Action dated <u>July 13, 2006</u> |
| 5. <input type="checkbox"/> Response to Notice of Incomplete Reply                | 14. <input type="checkbox"/> Notice of Appeal <input type="checkbox"/> Appeal Brief ____     |
| 6. <input type="checkbox"/> Request for Correction of Filing Receipt              | 15. <input type="checkbox"/> Claim for Convention Priority                                   |
| 7. <input type="checkbox"/> Information Disclosure Statement including:           | 16. <input type="checkbox"/> Preliminary Amendment                                           |
| - Form PTO 1449 and references ____                                               |                                                                                              |
| 8. <input checked="" type="checkbox"/> Response to Notice to File Missing Parts   | 17. <input type="checkbox"/> Revocation and Power of Attorney, including:                    |
|                                                                                   | - Statement Under 37CFR 3.73(b)                                                              |
|                                                                                   | - Copy of Assignment                                                                         |
| 9. <input type="checkbox"/> Fee Transmittal Sheet                                 | 18. <input type="checkbox"/> Other:                                                          |



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,250	12/09/2003	Michael Carter-Smith	P-6406-US	3360

49443 7590 07/13/2006  
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NEW YORK, NY 10036

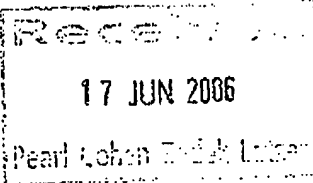
EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3734

DATE MAILED: 07/13/2006



Please find below and/or attached an Office communication concerning this application or proceeding.

JAN 11 2007

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/730,250	CARTER-SMITH ET AL	
	Examiner	Art Unit	
	Michael G. Mendoza	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 14 June 2006.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213

**Disposition of Claims**

4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed

6) ☒ Claim(s) 1-6 and 8-14 is/are rejected

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a)

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d)

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some c) ☐ None of.

1 ☐ Certified copies of the priority documents have been received

2 ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION*****Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention

3. Claims 1-6, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. It is not clear to the examiner if the applicant is claiming 2 visual indicators. In line 2 of claim 1 the applicant recites "a visual indicator" The applicant recites "a visual indicator" in line 5 of claim 1. If the applicant intends only on claiming one visual indicator, the examiner suggests rewording the line 5 to recite - -the/said visual indicator- -. The examiner will examine the claims as the ring only having one visual indicator.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of application for patent in the United States

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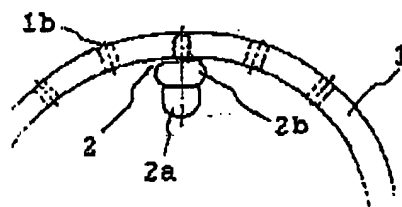
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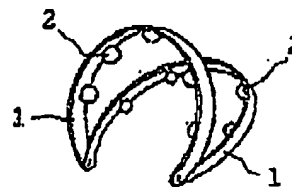
6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirano JP 11028242.

7. Hirano teaches an acupressure ring comprising: two or more rings having a visual indicator visible when the ring are worn and a projection extending inwardly from an inner surface of the acupressure ring, the projection being approximately orthogonal to a visual indicator, wherein the visual indicator is provided by a break in the acupressure ring; wherein the projection has a mid-point, which is approximately 90 degrees around the acupressure ring from the mid-point of the visual indicator; the cross section of the projection is round, cylindrical, conical, square or rectangular; wherein the projection is a single projection (Embodiment of fig. 3 shows holes 1b that can be used to place the projection 2 in multiple positions including orthogonal to the visual indicator. Also as translated by the abstract, the projection can be provided with a slide mechanism so that the position of the projection 2 attached to the ring can be varied.), and wherein the acupressure ring is comprised of two rings; wherein a bridging member connects each one of the rings.

【図3】



【図4】



8. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller 5636531.

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9. Miller teaches an acupuncture ring comprising a ring having a screw, the screw comprising a shank extending through the ring, being approximately orthogonal to a visual indicator (The applicant does not disclose what the visual indicator comprises, therefore the side of the ring of Miller can also be described as a visual indicator the is orthogonal to shank.); the shank being attached at one end to a head portion and bearing a screw portion engaging with a corresponding screw extending through the ring; the shank has an enlarged portion at the end of the end remote from the head.

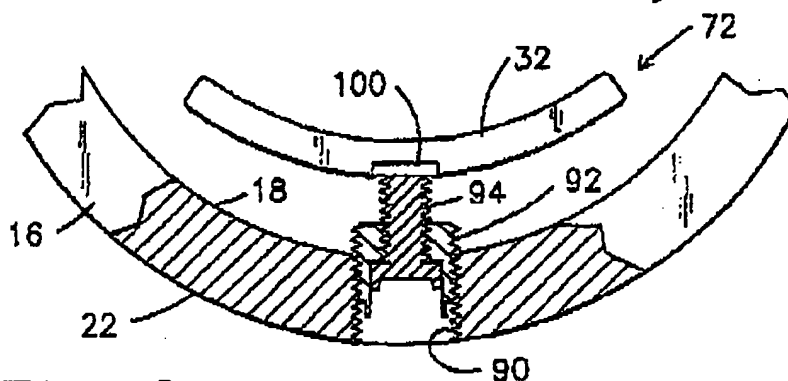


Fig. 8

**Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano

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12. Hirano discloses the claimed invention except for the recited distance values. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the recited ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. Claims 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

14. As to claims 11 and 14 Miller teaches a fully adjustable telescoping set screw (col. 6, line 64 – col. 7, line 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the set screw adjustable to at least 2.5 mm into the ring to allow for adjust to a finger that is smaller in diameter to the actual diameter of the ring.

15. As to claim 13, Miller discloses the claimed invention except for the enlarged portion is removable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the enlarged portion removable, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

#### **Remarks**

16. In response to applicant's arguments, the recitation "for use on the outer finger" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

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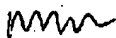
claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### Contacts

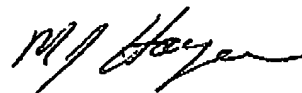
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MM



MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER